

REMARKS

Examiner has rejected Claims 3-15 and 17-48 under 35 U.S.C. 103(a) as being unpatentable over Daller (U.S. Patent No. 2,143,844), Madderom (U.S. Patent No. 5,912,197), Wikle (U.S. Patent No. 2,774,402), and/or Daniels (U.S. 2,428,266). Applicant addresses each of Examiner's various rejections of the Claims as follows:

Objective of Applicant's Invention:

As claimed, the purpose or objective of Applicant's invention is to provide a method of high-speed bag manufacturing utilizing preferred materials, and methods of orienting and manipulating such materials, to provide a preferred bag structure. As Applicant will demonstrate in the following arguments, the combined teachings of the cited prior art fail to disclose Applicant's method of high-speed bag manufacturing, and the preferred bag structure yielded therefrom.

Establishing a Prima Facie Case of Obviousness:

Applicant notes that the burden of establishing a *prima facie* case of obviousness lies with the Patent Office. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) (stating: "The PTO has the burden under section 103 to establish a *prima facie* case of obviousness"). To establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations. See MPEP 2142-43.

Examiner's Obviousness-Based Rejection of Claims 3, 4, 7-12, 15, 17 and 18:

Examiner asserts that cited prior art references to Daller and Madderom teach or disclose Applicant's invention as claimed in Claims 3, 4, 7-12, 15, 17 and 18. However, Applicant respectfully asserts that the **cited prior art references fail to teach or suggest all the claim limitations** of Applicant's Claims, as amended, and that **there is no suggestion or motivation to combine the reference teachings**. As such, said cited prior art references do not establish a *prima facie* case of obviousness against the rejected Claims. Reconsideration is respectfully requested.

Specifically, Applicant has now amended the Claims to delete the phrase "capable of being" presented before the claim language "V-folded along a central axis to form a closed butt end," and as presented before the claim language "sealed via a thermoplastic sealing strip to form a bag having at least one opening." Applicant respectfully asserts that neither Daller nor Madderom teach either of the foregoing positively claimed patentable limitations.

With regard to Daller, Applicant asserts the following: (1) Daller does not disclose a bag manufacturing method, or bag produced thereby. Instead, Daller discloses a cellophane wrapper for bread loafs. (2) Daller does not teach V-folding along a central axis to form a closed butt end of a bag. (3) Daller does not teach a process of sealing a sheet via a thermoplastic sealing strip to form a bag having at least one opening. (4) Daller does not teach a polyolefin film at all. (5) Daller does not teach a polyolefin central film portion functioning as a label section or for receiving print. Instead, Daller teaches that a section of "wax paper 12" may receive print, but makes no disclosure of the cellophane portion receiving print or that it could even receive print and act as a label section. Applicant

respectfully requests that Examiner specifically cite the portions of Daller which describe the foregoing elements claimed in Applicant's Claims, as amended.

With regard to Madderom, Applicant asserts the following: (1) Madderom does not teach V-folding along a central axis to form a closed butt end of a bag. Madderom specifically discloses a method of tube bag manufacturing, and a tube bag produced therefrom. Tube bags cannot, and are not, V-folded during the bag manufacturing process, but rather are drawn over a tube-forming mandrel. This tube-forming process is specifically disclosed in Madderom. Forming a bag via V-folding is an inherently different process of bag manufacturing, particular to Applicant's invention, which yields an inherently structurally different bag. There would be no motivation or suggestion to turn to the tube-bag manufacturing process of Madderom (in view of Daller or otherwise) to provide Applicant's V-folded bag manufacturing process. Although Madderom discloses a "centerline 104", such is not a fold line utilized to create the tube bag configuration of Madderom. (2) Madderom does not teach Applicant's polyolefin central film portion functioning as a label section. Instead, Madderom discloses a tube bag comprising a print band 18 overlying and attached to the exterior of the tube bag (see Madderom, Figure 1 and 5, Col. 4, lines 13-14), and more specifically wherein print band 18 is "sealed to mesh layer 12a on the front of the bag 26..." (see Madderom, Figure 5, lines 7-8). Applicant asserts, as is evident and clearly presented in Madderom, that the print band 18 of Madderom is a piece of film sealed to the exterior of the Madderom bag, as opposed to Applicant's bag with label section, wherein Applicant seals the edges of sections, or continuous streams, of mesh fabric to the opposing edges of a section, or continuous stream, of film. Applicant respectfully asserts that the Madderom bag

configuration, and method of producing a bag with label section, is impractical, as it wastes material; that is, because the Madderom print band 18 overlays a mesh body 12, the mesh material directly under print band 18 is wasted. Applicant's bag-making method avoids such a configuration by heat sealing the edges of Applicant's mesh portions to the edges of a film portion, and forming an enclosure or bag from a combination of such mesh and film portions. Applicant respectfully requests that Examiner specifically cite the portions of Madderom which describe the foregoing elements claimed in Applicant's Claims, as amended.

As set forth hereinabove, the combination of the cited prior art references to Daller and Madderom fails to teach or suggest Applicant's invention, as recited in the amended Claims. Thus, it is respectfully submitted that all of the claim limitations of the rejected claims are not disclosed by the cited prior art reference to Daller in view of Madderom and, as such, said cited prior art references do not establish a *prima facie* case of obviousness against Claims 3, 4, 7-12, 15, 17 and 18, as amended. Moreover, Applicant respectfully asserts that one skilled in the art would not turn to the bread loaf wrapper teachings of Daller in view of Madderom's tube-bag teachings to arrive at Applicant's claimed method. Indeed, there would be no motivation or suggestion to combine the two references for such a purpose. Reconsideration is respectfully requested.

Impermissible Hindsight:

Applicant further respectfully submits that since there is in fact no teaching in the cited prior art references of Daller and Madderom to provide Applicant's recited claim limitations, the only source of these factors must have been Applicant's invention. It is an improper use of hindsight to read Applicant's teachings into the prior art. Indeed MPEP

2143.01 requires that the prior art disclose a teaching or motivation before it is proper to combine references to make an obviousness rejection. Without the teaching of Applicant's disclosure, there is no reason that one of ordinary skill in the art would have made the asserted combinations of the cited prior art. For instance, nothing in Daller suggests utilizing thermoplastic sealing strips, whether of Madderom or otherwise, to form a bag from the claimed wrapper product. Additionally, neither Daller nor Madderom suggest V-folding their respective products (i.e., wrapper and tube-bag, respectfully) to provide Applicant's claimed bag-manufacturing process, or a bag having a closed butt-end produced therefrom. Indeed, absent Applicant's teachings, there would be no such suggestion or motivation to utilize the respective teachings of Daller and Madderom to arrive at Applicant's claimed invention, and certainly no reasonable expectation of success in manufacturing Applicant's bag, as neither Daller nor Madderom teach or disclose all of the claim limitations of the rejected Claims.

As the Court of Appeals for the Federal Circuit noted in the case of *ASC Hospital Systems, Inc. v. Montefiore Hospital et al.*, 221 USPQ 929, 933:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The prior art of record fails to provide any such suggestion or incentive. Accordingly, we hold that the Court below erred as a matter of law in concluding that the claimed invention would have been obvious to one of ordinary skill in the art under Section 103.

As in the *ASC Hospital* case, and in view of the foregoing arguments, there is certainly no teaching, suggestion, or incentive to provide Applicant's present invention from the cited references – one which teaches wrapping for bread loafs and further fails to teach a

method of high-speed bag manufacturing (Daller), and the other which teaches a tube-bag and method for manufacture thereof (Madderom). Further, neither cited reference teaches Applicant's claimed central polyolefinic-based film/label section in the claimed bag manufacturing process. Additionally, even accepting hypothetical combination, the present references would still be lacking distinct elements of the present claims as set forth above.

Moreover, there are a number of evaluations required under Section 103. One highly relevant inquiry is "[t]he relationship between the problems which the inventor...was attempting to solve and the problem to which any prior art reference is directed." *Stanley Works v. McKinney Manufacturing Co.*, 216 USPQ 298, 304 (De. D.C. 1981). Thus, in analyzing the prior art under Section 103, we must clearly comprehend the problem addressed by the present inventor and that must be compared or contrasted, as the case may be, with the problems addressed by the prior art.

Pursuing further the "problem" analyses required under Section 103, the applicability of any reference against the claims of a pending U.S. patent application requires compliance with *In re Gibbons*, 100 USPQ 398, where it is stated that:

In considering the question of invention, it is necessary to determine whether or not the art relied upon contains adequate directions for the practice of the invention without resort to the involved application. (emphasis added).

Amended claims 3, 4, 7-12, 15, 17 and 18 of the present invention recite Applicant's method of high-speed bag manufacturing. The problems addressed by cited prior art reference to Daller and Madderom are distinctly and inherently different from that of Applicant's claimed method. Again, Daller does not even teach a bag-manufacturing method

(but rather a wrapper), and Madderom altogether teaches an inherently different bag manufacturing method and bag produced therefrom (i.e., tube bags with an exteriorly affixed label section). The cited prior art lacks the requisite “adequate directions” to reach the presently claimed invention “as a whole” by reliance upon the prior art and without hindsight dependence upon the present application. The art relied upon by Examiner in rejection of Claims 3, 4, 7-12, 15, 17 and 18 does not contain adequate directions for the practice of Applicant’s claimed method of high-speed bag manufacturing or the bag produced thereby. Thus, it is respectfully submitted that a *prima facie* case of obviousness cannot be maintained against Claims 3, 4, 7-12, 15, 17 and 18, as amended, and reconsideration is respectfully requested.

Examiner’s Obviousness-Based Rejection of Claims 19, 5, 6, 13, 14 and 20-25:

Examiner asserts that cited prior art references to Daller and Madderom in view of Wikle teach or disclose Applicant’s invention as claimed in Claims 19, 5, 6, 13, 14 and 20-25, wherein the Examiner’s rejections based on Daller and Madderom are duplicative of those raised in connection with rejected Claims 3, 4, 7-12, 15, 17 and 18. Accordingly, so as to avoid reiterating Applicant’s above arguments with regard to Daller and Madderom, and Applicant’s arguments of a *prima facie* case of obviousness and impermissible hindsight, Applicant respectfully requests that Examiner refer to and consider said foregoing arguments responsive to such duplicative arguments, in view of Applicant’s following arguments specifically directed to Wikle (although Applicant will refer in pertinent part to said foregoing arguments, where appropriate).

Examiner combines the teachings of Daller and Madderom with that of Wikle, and, with specific reference to Claim 19, asserts that Wikle teaches “a fabric section comprising a width at least equal to a combined width of a film section and a second fabric section.” In response thereto, Applicant respectfully traverses Examiner’s rejection, asserting that Wikle, in combination with Daller and Madderom, fails to teach all of the claim limitations of the rejected claims, and specifically Claim 19, and, as such, said cited prior art references do not establish a *prima facie* case of obviousness against said rejected Claims, as amended.

Specifically, assuming, hypothetically, that Wikle teaches “a fabric section comprising a width at least equal to a combined width of a film section and a second fabric section,” Wikle still fails to teach a remaining patentable limitation recited in Applicant’s Claim 19 after the above quoted claimed language, which is as follows: “such that a central axis is disposed on said first open fabric section.” Based on the disclosure and figures of Wikle, it is evident that the central axis of Wikle is drawn through its “first fabric” section, its film section, and its “second fabric section” – not through the first fabric section alone, as is claimed by Applicant. Applicant respectfully directs Examiner’s attention to Figure 2 of the Wikle patent, which illustrates the manner in which the Wikle material is folded to create the claimed bag. According to Figure 2, the Wikle central axis would be an imaginary line drawn through all three regions of the bag, and certainly would not be the V-fold line as is contemplated and claimed by Applicant.

Additionally, absent use of Applicant’s teachings (i.e., impermissible hindsight), nothing in Wikle, whether combined with Daller, Madderom or otherwise, suggests that providing “a fabric section comprising a width at least equal to a combined width of a film

section and a second fabric section, such that a central axis is disposed on said first open fabric section” would in any way facilitate a method of high-speed bag making, as claimed by Applicant. Applicant respectfully requests that Examiner specifically cite the portions of Wikle, Daller or Madderom which might otherwise describe the foregoing elements and/or process steps as claimed in Applicant’s amended Claims, and which might otherwise demonstrate or suggest a reasonable expectation of success in facilitating the high-speed manufacture of Applicant’s bag.

Nonetheless, and in view of Applicant’s above arguments in connection with Madderom and Daller, Applicant respectfully asserts that the combined teachings of Daller, Madderom, and Wikle, fail to teach, disclose or suggest all of the claim limitations of the rejected claims, as amended, and, as such, said cited prior art references do not establish a prima facie case of obviousness against Claims 19, 5, 6, 13, 14 and 20-25, as amended. Reconsideration is respectfully requested.

Examiner’s Obviousness-Based Rejection of Claims 26, 27, 29-35 and 37-41 and Claims 42, 28, 36 and 43-48:

Examiner asserts that cited prior art references to Daller and Madderom in view of Daniels teach or disclose Applicant’s invention as claimed in Claims 26, 27, 29-35 and 37-41, and that Daller, Madderom, and Wikle, in view of Daniels teach or disclose Applicant’s invention as claimed in Claims 42, 28, 36 and 43-48, wherein the Examiner’s rejections based on Daller, Madderom and/or Wikle are substantially duplicative of those raised in connection with rejected Claims 3, 4, 7-12, 15, 17 and 18, and with rejected Claims 19, 5, 6, 13, 14 and 20-25.

However, in view of Applicant's above arguments with regard to Daller, Madderom, and Wikle, and Applicant's arguments of a *prima facie* case of obviousness and impermissible hindsight, Applicant respectfully asserts that even with Daniels' teaching of a feeding means (albeit for the tube-bag manufacturing process), all of the claim limitations of Applicant's rejected Claims 26, 27, 29-35, 37-41, 42, 28, 36 and 43-48, are not disclosed by the cited prior art references to Daller, Madderom, Daniels and/or Wikle, and, as such, said cited prior art references do not establish a *prima facie* case of obviousness against said rejected Claims, as amended. Reconsideration is respectfully requested.

CONCLUSION

The above-made amendments are to form only and thus, no new matter was added. Applicant respectfully believes the above-made amendments now place the Claims and application in condition for allowance. Should there be any questions or concerns, the Examiner is invited to telephone Applicant's undersigned attorney.

Respectfully submitted this 1st day of April, 2005.



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